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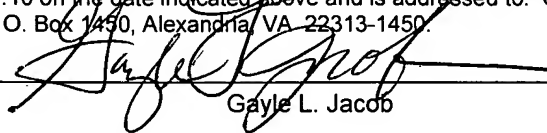


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Gayle L. Jacob

In re application of: Keith G. Lintott

Art Unit: 1661

Appl. No.: 10/693,738

PTO Confirmation No.: 3100

Filed: October 24, 2003

Examiner: June Hwu

For: Chrysanthemum Plant Named 'Starlet White'

Atty. Docket: 10451.0060.NPUS01

**RESPONSE TO REQUIREMENT FOR INFORMATION UNDER 37 CFR § 1.105
MAILED AUGUST 6, 2004**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to a Requirement for Information Under 37 CFR § 1.105 mailed August 6, 2004.

Claim 1 is pending in the application and the Examiner believes that an issue of public use or on sale activity has been raised. The Examiner has required Applicant and Assignee (collectively referred to here as "Applicant") to provide additional information that the Examiner has determined is reasonably necessary to properly consider patentability of the claimed invention under 35 USC § 102(b). In particular, the Examiner has required Applicant to explain why a 2002 Garden Mum Catalog was not an offer for sale. The

Examiner has also required additional information regarding the offer and sale of the claimed variety that is addressed below.

In 2001, Royal Van Zanten was the exclusive U.S. distributor for the Chrysanthemum varieties of Cleangro Ltd, assignee of the current application. *See* Declaration of Peter Hesse filed June 14, 2004 ("Hesse Decl."), ¶ 3. This included the variety that is the subject of this application with an effective filing date of October 24, 2002. The variety was ready for patenting more than one year prior to the effective date of the instant application.

Also in 2001, Ball Seed Company and its sister company, Ball Superior (collectively "Ball Seed"), became the exclusive sales representative for Royal Van Zanten in the United States and Canada. *See*, Hesse Decl. at ¶ 3. To the Applicant's best knowledge, Ball Seed, as the exclusive sales representative, generally distributed Chrysanthemum varieties in the U.S. and Canada for Royal Van Zanten, i.e., accepted orders from customers and purchased varieties (as cuttings) from Royal Van Zanten for resale to the customer. It is Applicant's understanding that Ball Seed was also able to order varieties on speculation for resale later in response to subsequent customer orders. Applicant believes that Ball Seed was an independent company operating at arm's length from Royal Van Zanten and was not controlled by Royal Van Zanten or Cleangro. Royal Van Zanten was owned by Royal Van Zanten (Europe), which was also part owner of Cleangro.

The 2002 Royal Van Zanten Garden Mum Catalog was printed on or about October 12, 2001. Hesse Decl. at ¶ 5. Copies of the 2002 Catalog were taken to a conference between Royal Van Zanten and Ball Seed on October 17, 2001, to introduce the varieties shown in the catalog to the Ball Seed sales representatives, including the variety that is the subject of this application. *Id.* The catalog was subsequently mailed out to potential customers of Ball Seed and Royal Van Zanten in the U.S. and Canada. *See* Hesse Decl. at ¶¶

5, 7-8. Based on the mailing date for the catalog, the catalog would not have been received by the customers prior to October 25, 2001. *Id.* Since the 2002 Catalog was not distributed more than one year prior to the effective U.S. filing date of the instant application, it does not give rise to an on sale issue as to those customers who received it by mail.

Although the catalog was given to Ball Seed more than one year prior to the effective U.S. filing date, the catalog itself was not an offer of sale either at the time it was presented to the Ball Seed sales representatives or subsequently when mailed to potential customers. The catalog was merely an advertisement disclosing the Chrysanthemum varieties of Royal Van Zanten during the 2002 catalog year. *See Hesse Decl. at ¶ 4.* There are no terms of sale given in the catalog, no order forms, no shipping information or cost schedule, and no pricing information or royalty listing for any variety contained there. Although the catalog admits generally at page two that Royal Van Zanten produces and sells Chrysanthemum cuttings, it makes no reference to the sale or offer of sale of any particular variety in the catalog, including the variety at issue in this application. In addition, to the Applicant's best knowledge, final sale terms such as pricing schedules for the 2002 Catalog were not agreed by Ball Seed and Royal Van Zanten until after the catalog was mailed out to the potential customers and were only available by separate inquiry apart from the catalog. *See Hesse Decl. at ¶ 6.* Moreover, it is Applicant's understanding that Ball Seed would not make or accept any order or offers until at least final pricing terms were agreed.

In and of itself, then, Applicant believes that the catalog did not constitute an offer of sale. *See, Group One, Ltd. v. Hallmark Card, Inc.*, 254 F.3d 1041, 1048 (Fed. Cir. 2001) ("mere advertising and promoting of a product may be nothing more than in invitation for offers"). Pricing information and orders had to be made separately by contacting Ball Seed or Royal Van Zanten directly or through Ball Seed's website. *Hesse Decl. at ¶ 6.* Indeed, the

back page of the catalog invited the viewer to “[p]lease contact the Ball salesman in your area for information or orders.” The catalog alone lacks all of the characteristic indicia of a UCC offer for sale. *See for example, Linear Technology Corp. v. Micrel*, 275 F.3d 1040, 1050 (Fed. Cir. 2002) (“An offer is the manifestation of willingness to enter into a bargain so made as to justify another person understanding that his assent to that bargain is invited and will conclude it.”) quoting *Restatement (Second) of Contracts* § 24 (1981). Moreover, there is no language comprising an offer of sale in the catalog that could have been independently and unilaterally accepted without more by Ball Seed (or any other potential customer) to create a binding UCC contract. *See, GroupOne, Ltd.*, 254 F.3d at 1048 (“[o]nly an offer which rises to the level of a commercial offer for sale, one which the other party could make into a binding contract by simple acceptance (assuming consideration) constitutes an offer for sale under § 102(b)”). The invitation to “[p]lease contact the Ball Salesman in your area for information or orders” does nothing to cure the lack of commercial sale terms since that contact information makes no offer of sale either. Thus the catalog itself is fatally defective as evidence of on sale activity.

Moreover, to the Applicant’s best knowledge, there were no sales or offers of sale of the instant variety prior to the distribution of the 2002 Catalog by mail or, in fact, prior to October 24, 2001. Simply as a practical matter, potential customers would have had no knowledge of the existence of the claimed variety prior to receipt of the catalog by mail, so an offer or sale to such a customer could not have occurred sooner. Applicant has been unable to determine the exact date of the first sale or offer of sale of the instant variety but believes that the earliest it could have occurred would have been through contact with Ball Seed or its website after the catalogs were received in the mail by potential customers and assuming pricing and sale terms were agreed by Ball Seed and Royal Van Zanten. That date

could not have been prior to October 25, 2001. The first royalty for the claimed variety was not received by the Assignee until at least December 2001 and the first shipping date for the claimed variety does not appear to have occurred until at least December 2001 also.

The Examiner has questioned whether sales representatives of Ball Seed were able to place orders for the claimed variety at the time of the conference with Royal Van Zanten on October 17, 2001. Catalogs were distributed to the Ball Seed sales representatives at the conference to introduce the Royal Van Zanten varieties to them (*see* Hesse Decl. at ¶ 5), but as discussed above, the catalogs themselves were not an offer of sale. Such an order by Ball Seed would have had to occur before pricing was determined since, as noted above, pricing information for the claimed variety as shown in the catalog was not agreed until at least the time the catalogs were mailed out to potential customers. Moreover, as also noted above, it is Applicant's understanding that Ball Seed would not make or accept any such order until pricing was agreed. Regardless, however, of whether it was theoretically possible for the Ball Seed representatives to place orders as of October 17, 2001, Applicant is not aware of any evidence of such an offer or sale, and to the Applicant's best knowledge, no such sale or offer ever occurred.

The Examiner has also requested further information regarding sales made by Royal Van Zanten directly to a limited number of customers in the U.S. other than through Ball Seed. *See* Hesse Decl. at ¶ 3. To the Applicant's best knowledge, any such sales would only have occurred by direct contact with a select few customers based upon the varieties shown in the 2002 Catalog. As a practical matter, such customers would not have been aware of the variety that is the subject of this application prior to receipt of the catalog by mail, because no other public disclosure of the variety was made prior to the release of the catalog. *See* Hesse Decl. at ¶ 9. Therefore, no such direct sale or offer of sale would have occurred more than

one year prior to the U.S. filing date. Indeed, Applicant is not aware of any direct sale or offer of sale of the variety that is the subject of this application more than one year prior to effective filing date or prior to the mailing of the 2002 catalog, the first royalty payment and shipping date not occurring until at least December, 2001 as noted above.

The Examiner has also inquired whether any orders for the instant variety were received prior to October 24, 2001 and whether any acceptance of any offer was made prior to that date. To the Applicant's best knowledge, no orders were made or accepted prior to that date for the instant variety.

CONCLUSION

It is respectfully submitted that the Applicant has fully responded to the Examiner's Requirement for Information under 35 U.S.C. § 1.105 and that a rejection under 35 U.S.C. § 102(b) does not apply. There are no other rejections or objections to the disclosure or the claim and the application is now believed to be in condition for allowance.

A three-month extension of time to file this response has been requested by separate petition. No additional fees beyond the three month extension of time are believed to be due, however, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 08-3038 referencing docket number 10451.0060.NPUS01.

The Examiner is invited to contact the undersigned attorney at (650) 463-8234 regarding any further questions, comments or suggestions relating to this patent application.

Dated: December 20, 2004

Respectfully submitted,



Mark K. Dickson
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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

for FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$1,020.00)

Complete If Known

Application Number	10/693,738
Filing Date	October 24, 2003
First Named Inventor	Kieth G. Lintott
Examiner Name	June Hwu
Art Unit	1661
Attorney Docket No.	10451.0060.NPUS01

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 08=3038 Deposit Account Name: Howrey Simon Arnold & White LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Small Entity	
	Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20		
Indep. Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = _____ /50= _____ (round up to a whole number) x _____ = _____				

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Petition for Extension of Time - 3 month 1,020.00

SUBMITTED BY

Signature		Registration No. 32,889 (Attorney/Agent)	Telephone (650) 463-8234
Name (Print/Type)	Mark K. Dickson		Date 12/20/04

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.